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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,599	10/16/2001	Rony A. Abovitz	ZKT 2 0014	5128

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EXAMINER

JUNG, WILLIAM C

ART UNIT	PAPER NUMBER
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3737

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DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/978,599

Applicant(s)

ABOVITZ ET AL.

Examiner

William Jung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-15 and 17-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-15 and 17-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 2, 4-7, 9-15, 23, 24, 26, 27, 31, 32, 34-37, and 39 are rejected under 35

U.S.C. 102(a) as being anticipated by *Yanof et al* (US 6,035,228).

Claims 2, 5, 7, 9, 10, 11, 23, 24, 26, 31, 34-36, and 39: Yanof et al anticipate all claimed features in claims 2, 5, 7, 9, 10, 11, 23, 24, 26, 31, 34-36, and 39. Yanof et al disclose an image-guided surgery system where the system includes disposable or interchangeable surgical tool 38 with image guidance provided by CT scanner 18 shown in figure 1. The guidance system also includes control console including computer or CPU with display monitor. In figure 1, Yanof et al show that the control console is remote from the image guidance and surgical tool apparatus. The CPU in a typical imaging system includes software for image acquisition and processing with software fully capable of upgrade or update in accordance with functionality of the specific imaging and image guidance.

Claims 4, 27, 32, and 37: The part of CPU includes storage device, which may be optical disk, CD-ROM, etc. and the choice of digital medium for storage of the acquired data is a design choice.

Claims 6 and 12-15: The part of CPU and control console includes I/O interface (combination of keyboard, mouse, and display) with graphic display of the image data tracking

the movement of the surgical tool during the surgical procedure. Since the image acquisition of CT is three dimensional, it would be inherent that the image processing and image display would be three-dimensional.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8, 17-20, 25, 28-30, 33, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Yanof et al.*

Yanof et al anticipate all claimed features in claims 8, 17-20, 25, 28-30, 33, and 38. Yanof et al disclose an image-guided surgery system where the system includes disposable or interchangeable surgical tool 38 with image guidance provided by CT scanner 18 shown in figure 1. The guidance system also includes control console including computer or CPU with display monitor. In figure 1, Yanof et al show that the control console is remote from the image guidance and surgical tool apparatus. The CPU in a typical imaging system includes software for image acquisition and processing with software fully capable of upgrade or update in accordance with functionality of the specific imaging and image guidance. Furthermore, a typical surgical tool inserted in a patient is sterile and disposable, for example such as syringe. Since surgical tools are disposable, it is by definition, not reusable as claimed in claims 28 and 29.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Yanof et al* as applied to claim 2 above, and further in view of *Ergun et al* (US 6,007,243).

Yanof et al substantially disclose of all claimed features in claim 3. However, Yanof et al do not disclose movable or rolling cart for the remote control console. Ergun et al teach that the remote console 10 is placed on a movable cart, which controls the image acquisition and processing. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to apply the teaching of Ergun et al movable cart to Yanof et al's image guidance system's remote console.

#### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

*Yanof et al* (US 6,052,611), *Acker* (US 6,161,032), and *Foley et al* (US 6,021,343)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Jung whose telephone number is 703-605-4364. The examiner can normally be reached on Mon-Fri 8:30 AM to 5 PM.

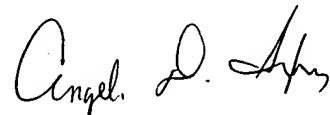
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703-308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LS

May 3, 2004



**ANGELA D. SYKES  
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